

REMARKS

Reconsideration and allowance of the subject application are respectfully requested. Applicants thank the Examiner for total consideration given the present application. Claims 1, 3-7, and 9-11 were pending prior to the Office Action. Claims 13-17 have been added through this reply. Claims 4-7 and 9-11 have been canceled withdrawn without prejudice or disclaimer of the subject matter included therein. Therefore, claims 1, 3, and 13-17 are pending. Claim 1 is independent. Applicants respectfully request reconsideration of the rejected claims in light of the remarks presented herein, and earnestly seeks a timely allowance of all pending claims.

Claim Rejection - 35 U.S.C. § 103(a)

Claims 1 and 3 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Uchida (U.S. Patent Publication No. 2002/0054028) in view of Labeeb et al. (U.S. Patent Publication No. 2003/0093792). Applicants respectfully traverse this rejection.

For a Section 103 rejection to be proper, a *prima facie* case of obviousness must be established. *See M.P.E.P. 2142*. One requirement to establish a *prima facie* case of obviousness is that the prior art references, when combined, must teach or suggest all claim limitations. *See M.P.E.P. 2142; M.P.E.P. 706.02(j)*. Thus, if the cited references fail to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

Argument 1 of 2: Features of claim 1 not taught by cited prior art:

In the response (dated February 23, 2009) to the previous Office Action (dated December 24, 2008), Applicants argued that “Uchida discloses EPG data in paragraph [0070] and further discloses, in paragraph [0074], that the set-top box 300 (Fig. 5) combines message information with the video signal or forms a video signal to be used to display EPG data, thereby to output this combined or formed signal. That is, in this configuration, Uchida forms a video signal on which EPG data is superposed not at the display apparatus 100 but at the set-top box 300.” (See response dated February 23, 2009, page 6, lines 2-7.)

In response to Applicants’ argument, the Examiner asserts that Uchida discloses the OSD processor of the set-top box 300. The OSD processor forms the EPG image, and is similar to the

OSD processor of the display apparatus 100 (see paragraph 73). In other words, the Examiner asserts that the OSD processing section 105 of the display apparatus 100 forms a video signal on which EPG data is superposed similarly to the OSD processor of the set-top box 300.

The Examiner further asserts that Uchida discloses that the display apparatus includes a memory, that is, various storage media such as ROM, RAM, and EEPROM devices, and further asserts that Labeeb discloses storing the EPG template at the STB as opposed to the cable headend in a conventional television broadcasting system.

The Applicants respectfully submit that the Office Action is based upon a selective combination of features found in the two references, and that such selective combining is impermissible. As stated in *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985), "When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." It is respectfully submitted that the Office Action cites the Uchida patent, and then utilizes the present application as a road map to selectively replace various features of the Labeeb reference.

The Examiner alleges that it would be obvious to combine Uchida with Labeeb to "increas[e] system response time for the user by decreasing overall system latency." (See Office Action dated April 15, 2009, page 6, lines 3-4.) It is respectfully submitted that the rejection of claim 1 is a blatant string of substitutions gleaned from and motivated by the Applicants' own patent application. The Office Action fails to show that the prior art provides the teaching or suggestion to make the claimed combination and the reasonable expectation of success. The suggestion to make the claimed combination and the reasonable expectation of success cannot be based on Applicants' disclosure. Accordingly, it is respectfully submitted that claim 1 is patentable over the impermissible combination of references cited against claim 1.

For example, as to the Examiner's assertion that the OSD processing section 105 of the display apparatus 100 forms a video signal on which EPG data is superposed similarly to the OSD processor of the set-top box 300, Uchida fails to disclose that the OSD processing section 105 of the display apparatus 100 forms a video signal on which EPG data is superposed. Uchida fails to disclose this because, in Uchida, it is *not* necessary for the OSD processing section 105 of

the display apparatus 100 to form such a video signal since the OSD processor of the set-top box 300 forms the video signal on which EPG data is superposed. Uchida merely describes (see paragraph 73) that the display information of characters, pictures, and symbols are displayed similarly to the OSD processing section 105 of the display apparatus 100, and fails to disclose that the OSD processing section 105 of the display apparatus 100 forms the video signal on which EPG data is superposed similarly to the OSD processor of the set-top box 300.

Also, as to the Examiner's assertion that Uchida discloses that the display apparatus includes a memory, that is, various storage media such as ROM, RAM, and EEPROM devices, and the further assertion that Labeeb discloses storing the EPG template at the STB as opposed to the cable headend in a conventional television broadcasting system, it is unobvious that the memory of the display apparatus of Uchida stores the EPG template data, even assuming *arguendo* that the display apparatus of Uchida includes the memory and the STB of Labeeb et al. stores the EPG template data. Further, it is even more unobvious that the EPG data is superposed on the video signal in the display apparatus.

Therefore, claim 1 is submitted to be allowable over Uchida and Labeeb for at least this reason.

Dependent claims are allowable for the reasons set forth above with regards to claim 1 at least based on their dependency on claim 1.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1 and 3 under 35 U.S.C. § 103(a).

Reconsideration and allowance of claims 1 and 3 are respectfully requested for at least these reasons.

Argument 2 of 2: Features of claim 1 not taught by cited prior art:

Applicants have amended independent claim 1 only to further clarify the claimed invention in order to move prosecution forward.

In the claimed invention of independent claim 1, the base device is configured such that the transmitting unit wirelessly transmits the first video data and the EPG data to the wireless

terminal. The base device includes the input terminal which is connectable with the set-top box, thus the set-top box can be connected to the base device.

Further, in the wireless terminal, the receiving unit wirelessly receives the first video data and EPG data from the base device. The first video generating unit generates a first video image based on the first video data, and the second video generating unit generates a second video image based on the EPG data. In this case, the second video generating unit generates the second video image based on the EPG data stored in the rewritable nonvolatile memory. Furthermore, the video superposing unit superposes the second video image on the first video image, so as to obtain a superposed image which is to be displayed on the display unit.

As described above, the claimed invention is arranged such that the base device wirelessly transmits, to the wireless terminal, the first video data and the EPG data, and in the wireless terminal, the second video image generated based on the EPG data is superposed on the first video image generated based on the first video data, so as to obtain a superposed image which is to be displayed on the display unit.

Accordingly, it is not necessary for the claimed invention to encode/decode the superposed video data, as compared to a conventional arrangement in which the generating the first video image based on the first video data, the generating the second video image based on the EPG data, and the superposing the second video image (EPG) on the first video image are carried out on the base device side. One benefit of the claimed invention is that the claimed invention makes it possible to improve speed of response to an input of user's instruction (see specification, line 16 of page 6 through line 2 of page 7).

While Uchida discloses the EPG data (see paragraph 70) and that the set-top box 300 (Fig. 5) combines message information with the video signal or forms a video signal to be used to display the EPG data (see paragraph 74), thereby to output this combined or formed signal. That is, in this configuration of Uchida, it is not the display apparatus 100 but the step-top box 300 that forms the video signal on which the EPG data is superposed. In the claimed invention, the set-top box 300 is to be connected to the input terminal of the base device.

Further, Labeeb merely discloses that the EPG memory 36 and the template memory 38 are provided in the set top box 34 which is connected to Cable Head End (see in paragraph 167 and Fig. 2).

Therefore, a configuration obtainable by combining Uchida and Labeeb is the one in which the EPG memory and the template memory are provided in the set-top box that forms the video signal on which the EPG data is superposed, and the superposed video signal is wirelessly transmitted to the display apparatus. Such a configuration fails to disclose the claimed invention in which the base device wirelessly transmits the first video data and the EPG data to the wireless terminal, and the wireless terminal superposes the second video image generated based on the EPG data, on the first video image generated based on the first video data.

Therefore, claim 1 as amended is submitted to be allowable over Uchida and Labeeb for at least this reason.

Dependent claims are allowable for the reasons set forth above with regards to claim 1 at least based on their dependency on claim 1.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1 and 3 under 35 U.S.C. § 103(a).

Reconsideration and allowance of claims 1 and 3 are respectfully requested for at least these reasons.

Conclusion

Therefore, for at least these reasons, all claims are believed to be distinguishable over the combination of Uchida and Labeeb, individually or in any combination. It has been shown above that the cited references, individually or in combination, may not be relied upon to show at least these features. Therefore, claims 1 and 3 are distinguishable over the cited references.

In view of the above remarks and amendments, it is believed that the pending application is in condition for allowance. Applicants respectfully request that the pending application be allowed.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Aslan Ettehadieh, Reg. No. 62,278,

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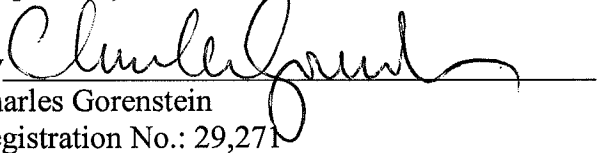
Docket No.: 1248-0823PUS1

at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.147; particularly, extension of time fees.

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Respectfully submitted,

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